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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,085	12/28/2001	Yonas D. Seme	41826888US	3973
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PERKINS COIE LLP/MSFT P. O. BOX 1247 SEATTLE, WA 98111-1247				
EXAMINER				
JACKSON, JAKIEDA R				
ART UNIT		PAPER NUMBER		
2626				
NOTIFICATION DATE		DELIVERY MODE		
10/30/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentprocurement@perkinscoie.com
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Office Action Summary

Application No.

10/035,085

Applicant(s)

SEME, YONAS D.

Examiner

JAKIEDA R. JACKSON

Art Unit

2626

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37-42 and 48-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 37-42 and 48-52 is/are allowed.
- 6) ☒ Claim(s) 53-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S5108)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Response to Amendment

1. In response to the Office Action mailed April 20, 2009, applicant submitted an amendment filed on August 3, 2009, in which the applicant amended and requested reconsideration.

Response to Arguments

2. Applicant's argue that the prior art cited does not specifically teach the independent claims 37 and 48 as amended. In particular, Applicant's argue that the prior art cited does not specifically teach during initiation of the instant messaging session between the first device and the second device, and prior to any message received from the first user being transmitted by the first device to the second device, sending by the first device to the second device an indication of the first translation preference and receiving by the first device from the second device an indication of the second translation preference, wherein the second translation preference is different from the first translation preference. Applicant's arguments, see pages 7-11, filed August 3, 2009, with respect to independent claims 37 and 48 have been fully considered and are persuasive. The rejection of claims has been withdrawn.

With regards to independent claim 53, Applicant's argue that the prior art cited does not specifically teach that the translation is based on either the country of origin or location information included in a user's profile. Applicant's arguments are persuasive, but are moot in view of new grounds of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 53-58** are rejected under 35 U.S.C. 103(a) as being unpatentable over Chin et al. (PGPUB 2001/0029455), hereinafter referenced as Chin in view of Dietz (USPN 6,385,586).

Regarding **claim 53**, Chin discloses the profile information is based on geographic information (figure 1, flags represent country of origin with location; paragraph 0261). Chin teaches this information is helpful to allow translations to be more effective and thereby more easily understood and a higher translation quality (paragraph 0111-0113). If the preferred target language is known by the users, it can help make the language as clean and proper as possible (paragraph 0137). Further, it can show users who understand at least some of the target language the strengths and limitations of the system and helps educate them about the most productive use if the translation engine (paragraphs 0178-0189). It also provides a communal nature of the chat room to allow users to help each other to find the best language for translation, helps users determine the best phrasing in order to achieve high-quality translation and once the user knows what the target language is, and there needs to be changes made,

the user can select the list for that language, which will provide the best language construction to user to produce the best translations (paragraphs 0222-0228), however, Chin does not specifically teach that the translation is based on either the country of origin or location information included in a user's profile.

Dietz discloses a method that translates a language based on geographical language (column 4, lines 43-64), to ensure that the information is being presented in the appropriate language.

Therefore, it would have been obvious to one of ordinary skill of the art at the time the invention was made to modify Chin's method as described above, to determine the native language based on the geographical location (column 4, lines 43-64), as taught by Dietz.

Regarding **claim 54**, Chin teaches a method the first geographic information includes a locality of the first user (figure 1 with paragraph 0261).

Regarding **claim 55**, Chin discloses a method wherein the computer system is the first device of the first user (computer; paragraphs 0005 and 0017-0018).

Regarding **claim 56**, Chin teaches a method wherein the computer system is a server (server; paragraphs 0110-0112).

Regarding **claim 57**, Chin discloses a method wherein the receiving of the first profile information (profile) and the receiving of the second message are performed at the second device and the receiving of the second profile information and the receiving of the first message are performed at the first device (paragraph 0117).

Regarding **claim 58**, Chin discloses a method wherein the receiving of the first profile information and the second profile information occurs during initiation of a session for exchanging messages (once user says hello, the profile information is transmitted also, figures 1 and 43).

Allowable Subject Matter

5. **Claims 37-42 and 48-52** are allowed.

The following is a statement of reasons for allowance:

As for independent claims 37 and 48, they recite a method for translating instant messages exchanged between a first user using a first device and a second user using a second user using a second device over a communication network. Prior art such as Chin and Stringham teach a similar method but fails to teach the recited method wherein during initiation of the instant messaging session between the first device and the second device, and prior to any message received from the first user being transmitted by the first device to the second device, sending by the first device to the second device an indication of the first translation preference and receiving by the first device from the second device an indication of the second translation preference, wherein the second translation preference is different from the first translation preference.

Dependent claims 38-42 and 49-52 are allowed because they further limit their parent claims.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAKIEDA R. JACKSON whose telephone number is (571)272-7619. The examiner can normally be reached on Monday-Friday from 5:30am-2:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Hudspeth can be reached on 571-272-7843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David R Hudspeth/
Supervisory Patent Examiner, Art Unit 2626

/Jakieda R Jackson/
Examiner, Art Unit 2626
October 19, 2009